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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Peter Taiana

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EXAMINER

PARKER, FREDERICK JOHN

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/563,724	Applicant(s) TAIANA, PETER	
	Examiner Frederick J. Parker	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4-3-06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

2. Claims 1,2,4,5,8,11,12,16,17 are objected to because of the following informalities: 1) claims 1,2,4,5,8,11,12,17 utilize ambiguous exemplification such as “in particular” and “in particular”, which are interpreted as being optional. 2) claim 16, line 1, the intended meaning of “it” is unclear and non-specific. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-9,11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 2: “stationary vibrating electrode” lacks antecedent basis.
- Claim 3 is vague and indefinite because the meaning of the phrase “an exciting means” in context is unclear.
- Claim 4 is vague and indefinite because it is unclear how the electrode is “excited...by an air stream”.

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Claims 5,12 are vague and indefinite because the intended shapes of “leaf shaped” and “tongue shape” are unclear since they could be of maple, birch, ginkgo, etc OR mammal, snake, etc, respectively.; “the opening” and “the air” lacks antecedent basis.

- Claims 2-9,11-14 are vague and indefinite because they require a single electrode whereas claim 1 on which they depend recites at least one electrode so it is unclear which “electrode” is intended when plural are present ; also the same electrodes are given different labels throughout, e.g. filed producing electrodes, vibrating electrodes, etc which is confusing.
- Claim 8 is vague and indefinite because the claim simultaneously requires the electrode arrangement to be stationary (line 3) and moveable (line 4-5) which is contradictory.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1,2,3,10-12,14,17 are rejected under 35 U.S.C. 102(b) as being anticipated by Point US 3336903.

Point teaches using an electrostatic fluidized bed device comprising electrodes 8 which are vibrated by means 5 to shake off adhered powder during coating of articles advanced past the electrodes (col. 4, 30-35, fig. 1, etc.)

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7. Claims 1,2,3,6,10-12,14 rejected under 35 U.S.C. 102(b) as being anticipated by Meston US 2173078.

Meston teaches a pile particle coating process and device in which a substrate 32 is run between electrodes 1,31 while the pile particles are electrostatically applied, upper electrode 31 is vibrated by means 40-44 in cycles to remove adhered particles. Page 2, 42-47; fig. 1 and accompanying text; etc.

8. Claims 1,2,3,6,10-12,14,17 are rejected under 35 U.S.C. 102(b) as being anticipated by Friderici US 32693656.

A coating method and device for same comprises electrostatically flocking fiber particles onto a substrate, in which the field forming electrodes are mechanically vibrated by means 35 and driven by means 36 to prevent build-up thereon. Fig. 1 and accompanying text; col. 3, 8-12; etc.

9. Claims 1,2,3,6,10-12,17 are rejected under 35 U.S.C. 102(b) as being anticipated by Grohl US 3255730.

The coating process and device comprises substrate 10 moving past electrostatic coating means 2-5 to apply fiber particles to support 10. Electrode 5 is a wire mesh which is vibrated by electromagnetic drive means 70. Fig. 1-2 and accompanying text; col. 2, 28-54.

10. Claims 8,9 are rejected under 35 U.S.C. 102(b) as being anticipated by Sedlacsik US 3290169.

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Sedlacsik teaches a method and device to electrostatically coat spaced articles by providing adjacent disc-shaped electrodes 24,42, rotated by means 20, to prevent accumulation of powder coating thereon. Rotation is continuous or periodic (col. 3, 11-45; fig. 1 and accompanying text; col. 4, 8-24; etc.

11. Claims 8,9,15,16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hajek US 4808432.

Hajek teaches a continuous coating method and device in which an electrode assembly 92,94 are of ring form, and contains vane elements 108 upon which an air stream impinges to provide motive force to rotate the assembly relative to the spaced continuous substrate. Fig. 1 and accompanying text; col. 5, 6-36, etc.

12. Claims 8,9,15,16 are rejected under 35 U.S.C. 102(b) as being anticipated by Smyser US 2447374.

Smyser teaches a method and device to electrostatically coat articles, one embodiment (col. 7, 15-col. 8,17; fig. 10 and accompanying text, etc) utilizing a rotating electrode 115 spaced from substrate 5, and further utilizing an air stream to prevent accumulation of coating material thereon.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 4,5,7,13 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Point or Meston or Friderici or Grohl, hereafter “The primary references”, which are cited for the same reasons previously discussed, which are incorporated herein, and further in view of the admitted Prior Art (APA), [0002].

While the primary references do not explicitly cite using an air stream to clean electrodes during coating, Applicants disclose in APA that it was known to clean an electrode in electrostatic coating processes by an air stream to prevent fouling of the electrode. It would have

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been obvious to one of ordinary skill in the art at the time the invention was made to carry out the methods with the devices of the Primary references by incorporating or substituting an air stream to clean electrodes during the coating process because the use of air streams to do so is well-known.

As to claim 5, the electrodes provided encompass a wide range of functionally equivalent shapes to provide equivalent charging effects, and hence it would have been obvious to use electrodes of any suitable shape to provide charging because utilizing a suitable electrode shape would have been an obvious modification within the purview of one skilled in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Frederick J. Parker
Primary Examiner
Art Unit 1792

/Frederick J. Parker/
Primary Examiner, Art Unit 1792